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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) S63.2-10447-US01	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>February 16, 2007</u> Signature <u></u> Typed or printed name <u>Elizabeth A. Deutsch</u>		Application Number <u>10/063937</u>	Filed <u>May 28, 2002</u>
		First Named Inventor <u>Gerberding</u>	
		Art Unit <u>3731</u>	Examiner <u>Elizabeth Houston</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		 Signature	
<input type="checkbox"/> applicant/inventor.		<u>Lisa Ryan-Lindquist</u> Typed or printed name	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)			
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>43071</u>		<u>952-563-3011</u> Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>February 16, 2007</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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FEB 16 2007

Application No.: 10/063937

Filed: May 28, 2002

REASONS FOR PRE-APPEAL CONFERENCE

Claims 1, 2, 4-10, 13-15, 26-28, 34 and 35 are pending in the application.
Claims 16-18 and 22-25 are withdrawn from consideration.

Claims 1, 2, 4-10, 13-15, 26-28, 34 and 35

In the Final Office Action mailed 10/31/2006, claims 1, 2, 4, 5, 7-10, 15, 26-28, 34 and 35 were finally rejected under 35 U.S.C. §103(a) as being unpatentable over Cox (USPN 6,652,579) in view of Erbel (US2004/0116998). The rejection was maintained in the Advisory Action mailed 1/22/2007.

Applicant disagrees with the rejection.

Claim 1 of the present application is directed to a medical device which includes, among other features, "...a first serpentine band and a second serpentine band adjacent thereto, each serpentine band formed of interconnected struts and having a distal end and a proximal end, each strut extending from a peak at the distal end of the serpentine band to a trough at the proximal end of the serpentine band, at least one of the struts being a special strut...."

Claim 26 recites, among other features, "each special strut extending from the peak of the serpentine band to the trough of the serpentine band and having a radiopaque marker therebetween."

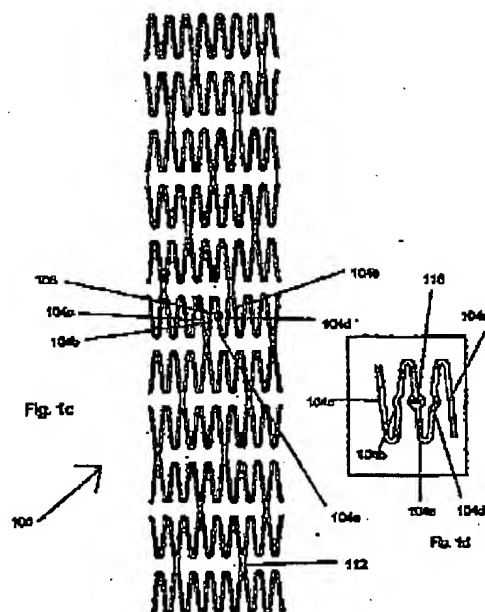
In the Advisory Action mailed 1/22/2007, it was asserted that "[r]egarding the applicant's argument that "special strut of the instant invention connects a peak to a valley within a serpentine band; there is no language recited in the claims that requires this limitation."

This is clearly incorrect. Applicant's claims 1 and 26 do recite that each strut extends from a peak at the distal end of the serpentine band to a trough at the proximal end of the serpentine band, and at least one of the struts is a special strut. Furthermore, the reference in the above reproduced recitations of claims 1 and 26 to "the serpentine band" is clearly indicative of reference to a single serpentine band.

Figures 1c and 1d of the present application have been reproduced below to illustrate the position of the special strut as recited in independent claims 1 and 26.

Application No.: 10/063937

Filed: May 28, 2002



As can be seen from these figures, the special strut 104a is located within a single serpentine band and extends from a peak at the distal end of the serpentine band to a trough at the proximal end of the serpentine band. Adjacent serpentine bands are connected to one another via one or more connecting struts 112, as shown in FIG. 1c above. See also paragraphs 26-32, for example. Please note that other figures in the present specification may also illustrate such features.

Furthermore, the claims must be interpreted consistently with the specification:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

Application No.: 10/063937

Filed: May 28, 2002

MPEP 2111. However, even if given their broadest interpretation, such interpretation must be consistent with the specification:

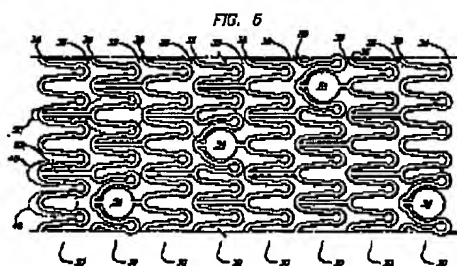
The claims...do not stand alone. Rather, they are part of "a fully integrated written instrument," *Markman*, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are a part." *Id.* at 979. As we stated in *Vitronics*, the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." 90 F.3d at 1582.

Phillips v. AWH Corp., 75 USPQ2d 1321 at 1327.

"Other claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term." *Phillips*, 75 USPQ2d at 1327. For example, see withdrawn claim 16 of the present application which is directed to an embodiment wherein the "special strut" is a connecting strut 112.

Thus, based on the specification, the drawings and the claims themselves, it is quite clear that the "special strut" recited in independent claims 1 and 26, does in fact, connect a peak to a valley within a serpentine band.

In rejecting the present claims in the Final Office Action mailed 10/31/2006, we were directed to figure 6 of Cox et al.:



The argument was made that Cox et al. disclose a special strut, and the "...special strut extends from (the direction of) the peak to (toward the direction of) the trough."

However, Applicant submits that the strut 54 shown in FIG. 6, actually extends from a trough of serpentine band 30 to a peak of an adjacent serpentine band 30,

Application No.: 10/063937

Filed: May 28, 2002

and does not extend from a peak at the distal end of a serpentine band to a trough at the proximal end of the serpentine band as recited in Applicant's claims.

Therefore, strut 54, shown in FIG. 6 of Cox et al., is not the same as the special strut 104(a) as defined in Applicant's specification and as recited in the claims.

Erbel has been combined with Cox et al. for the covering element recited in Applicant's claims. However, combining the covering of Erbel with Cox et al. fails to render Applicant's claims unpatentable because strut 54 disclosed by Cox et al. and shown in FIG. 6 above, is not the same feature as the "special strut" recited in Applicant's independent claims 1 and 26. Strut 54 of Cox et al. connects adjacent serpentine bands while the special strut, disclosed in Applicant's specification and as recited in Applicant's independent claims 1 and 26, extends between a peak and a trough within a single serpentine band.

Based on the foregoing, Applicant submits that independent claims 1 and 26 are not obvious over Cox et al. in view of Erbel. Claims 2, 4-10, 13-15, 34 and 35 depend from claim 1 and are not obvious over Cox et al. in view of Erbel for at least the reasons that claim 1 is not obvious over Cox et al. in view of Erbel. Claims 27 and 28 depend from claim 26 and are not obvious over Cox et al. in view of Erbel for at least the reasons that claim 26 is not obvious over Cox et al. in view of Erbel.

Claim 6

Claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Cox et al. in view of Erbel as applied to claim 1 above, and further in view of Barone (USPN 6,613,078).

It is asserted that Barone discloses two covers.

Applicants traverse the rejection.

Claim 6 depends from claim 1 and recited a second covering region.

However, as discussed above, Cox et al. fails to disclose or suggest a special strut connecting a peak to a trough within a serpentine band as recited in independent claim 1. Combining either the cover of Erbel or the covers of Barone fails to suggest the stent structure recited in claims 1.

Application No.: 10/063937
Filed: May 28, 2002

Claim 6 depends from claim 1 and is not obvious over Cox et al. in view of Erbel or Barone for at least the reasons that claim 1 is not obvious over Cox et al. in view of Erbel or Barone.

Claims 13 and 14

Claims 13 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Cox et al. in view of Erbel as applied to claim 1 above, and further in view of admitted prior art (admission). It is asserted in the Final Office Action that 13 Cox et al. in view of Erbel disclose the claimed invention as stated above except for the different forms of radiopaque markings.

Applicants disagree.

Claims 13 and 14 depend from claim 1.

The medical device recited in claim 1 is different than that of Cox et al. for the reasons discussed above. Cox et al. fails to disclose or suggest a "special strut" as recited in claim 1 and as disclosed in Applicant's specification. Combining the cover disclosed by Erbel with Cox et al. fails to suggest a special strut as recited in claim 1.

Further combining different kinds of radiopaque markings as asserted in the Final Office Action also fails to render claim 1 obvious because, as discussed above, because the combination of the different radiopaque markings with Cox et al. and Erbel, still fails to suggest the special strut as recited in claim 1.

Claims 13 and 14 are not obvious over Cox et al. in view of Erbel and further in view of different kinds of radiopaque markings for at least the reasons that claim 1 is not obvious over Cox et al. in view of Erbel and further in view of different kinds of radiopaque markings.

Applicants respectfully request reconsideration and withdrawal of the rejections of the claims as presented.

Respectfully submitted,
VIDAS, ARRETT & STEINKRAUS

Date: February 16, 2007

By: 

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